

## REMARKS

Please consider the foregoing amended claims and the following remarks in response to the Office communication mailed on October 7, 2009.

The claims have been amended to cover the preferred embodiments of the invention. Claim 12 has been combined with portions of claim 16 and claims 19, 21 and 23. Claim 19 has been combined with claim 25 and claim 26 has been rewritten to depend from claim 25. The remaining independent claims, 12 and 25, have been amended to require a topcoating which cures by drying as described in the specification at page 5, line 14. The terms "comprising" and "consisting essentially of" have been replaced with "consisting of" in all of the claims.

The present invention has to do with an electrically conductive floor covering having a transparent topcoating comprising a polymer and particles with a conductive coating. The topcoating does not increase the electrical resistance of the flooring significantly and it significantly improves flooring cleaning properties.

Claims 12, 15-18 and 23-26, now claims 12, 15, 18 and 24-26, are rejected as being unpatentable over U.S. Patent No. 5,516,546 (Hari et al.) in view of published U.S. Patent Application No. 2003/0113566 A1 (Clemens) and further in view of U.S. Patent No. 5,626,948 (Ferber) under 35 U.S.C. §103(a).

Hari, the primary reference, does not disclose or suggest a transparent topcoating. The conductive topcoating 5 of Hari is described in column 10, lines 46-67, of the reference. Among other things, the topcoating contains carbon fiber, aluminum powder, titanium dioxide rutile pigment and iron oxide black pigment, none of which are transparent. The coating is clearly pigmented and it contains several other ingredients

that are not transparent. If polyurethane was present, it would be pigmented along with the other ingredients of the coating. Hari is not concerned about making a transparent topcoating, a very important claimed feature of applicants' invention because transparency allows the substrate beneath the topcoating to show through. Hari's invention is concerned only with conductivity and as such he uses conductive materials that are not employed by applicants because they cannot be used in a transparent topcoating. There is no disclosure in Hari that would teach or suggest to one skilled in the art that silver coated glass beads could be used to make a transparent conductive topcoating for a conductive or antistatic flooring substrate.

Clemens has to do with a coating system that is field applied or shop applied over wood or concrete. The topcoat of Clemens is applied as a powder and flame sprayed. Applicants' claimed product is applied as a liquid that is cured by drying. The Clemens topcoat is applied at a thickness of 10 - 100 mills (i.e., 254 - 2540  $\mu\text{m}$ ). (See Clemens ¶[0054].) Applicants' claimed topcoat can be orders of magnitude thinner at a thickness of 0.5 - 100  $\mu\text{m}$ .

Clemens employs a topcoat thermoplastic composition that is pigmented and can contain fillers. (See ¶¶ [0020] – [0029].) When the reference is considered as a whole, it is clear that the Clemens topcoat is not transparent. In fact, the topcoat of Clemens provides the decoration to his coating system as opposed to applicants' claimed surface covering wherein the transparent topcoat allows the underlying substrate to show through. This fact is reinforced by the disclosure at paragraphs [0113], [0114] and [0118] describing the use of the topcoat composition as a stand alone coating. Paragraph [0118] reads as follows: "All coatings can be made available

in virtually an unlimited array of color selections and finishes. From fluorescent to jet-black; from smooth-high gloss, dimple and pinhole free surface-to wrinkled textures; as well as colors and finishes between these extremes." The requirement of pigments and optional fillers by Clemens teaches away from applicants' claimed invention because a colored and decorative topcoat has a decorative purpose whereas a transparent topcoat as claimed by applicants allows the substrate to show through. In making the rejection, improper hindsight is used to select elements from Clemens that would make a transparent coating. But nowhere in Clemens does he describe his coating as transparent. In contrast, as explained above, his coating is described as decorative.

In summary, the Clemens topcoating is distinguished from applicants' topcoating in many respects. The Clemens topcoating is thermally cured and applicants' is cured by drying. The Clemens topcoating must be substantially thicker than applicants' topcoating. Clemens does not describe his topcoating as transparent and applicants' topcoating must be transparent. Thus, the combination of Clemens with Hari cannot make applicants' claimed invention and the combination cannot support the Section 103 rejection. The rejection must be withdrawn.

Ferber has to do with a multi-layer conductive composition for use in connection with an electrical system. The reference has nothing to do with floor or wall coverings. As such, Ferber cannot properly be used in support of a rejection under 35 U.S.C. §103.

Ferber is also distinguished from the presently claimed invention. The reference describes a top composition layer comprising a substantial amount of pigment in order to mask the bottom composition layer and impart desired color to the Ferber system.

According to Ferber, "A need has arisen for colored conductive compositions which are available in a wide variety of colors to be used as part of an electrical system on the surface of substrates." (See Ferber, col. 2, ln. 14-16.) Ferber goes on to say.

"The prior art has also failed to provide a conductive composition for use as part of an electrical system which is vertically conductive, as defined herein, and which comprises multiple layers wherein the top layer masks one or more lower layers. The present invention addresses the aforementioned shortcomings and needs of the prior art." (See Ferber, col. 2, ln. 22-27.)

Ferber's top composition layer is not transparent and it cannot support the rejection.

In making the rejection based on Ferber, improper hindsight is used to select elements from Ferber that are alleged to make a transparent coating. Just because pigment is not required in all embodiments of the invention does not mean the Ferber coating is transparent. As illustrated by the quoted citation from Ferber above, the Ferber top layer "masks one or more lower layers." Whether or not the layer contains pigment, it cannot be transparent because it must mask one or more lower layers.

The combination of Hari with Clemens and Ferber cannot make applicants' claimed invention or render obvious applicants' claimed invention. Withdrawal of the rejection of claims 12, 15, 18 and 24-26 under 35 U.S.C. §103(a) as being unpatentable over Hari in view of Clemens and further in view of Ferber is respectfully requested.

As to the rejections of remaining claims 18 and 24, these are dependent from allowable claims and their allowance is accordingly required.

We note that claim 19 is rejected under 35 U.S.C. §103(a) as being unpatentable over Hari in view of Clemens and Ferber as applied above and further in

view of either U.S. Patent No. 5,120,811 (Glottfelter) or published U.S. Patent Application No. 2005/0227104 A1 (Kim). Claim 19 has been combined with claims 12 and 25 and the claim provides for a topcoating thickness of between 0.5  $\mu\text{m}$  and 100  $\mu\text{m}$ . The disclosures of coating thicknesses provided by Glottfelter or Kim are not sufficient to overcome the deficiencies of Hari, Clemens and Ferber. Withdrawal of the 35 U.S.C. §103(a) rejection of claim 19 is therefore respectfully requested.

We note also that claims 21 and 26 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hari in view of Clemens and Ferber as applied above and further in view of U.S. Patent No. 4,101,689 (Wienand et al.). Claim 21 has been combined with claim 12 and claim 26 has been amended to depend from claim 26. There is nothing about Wienand that would make applicants' product obvious because Weinand's construction is completely different from applicants' construction. Furthermore, the primary references in this rejection, Hari, Clemens and Ferber, have been distinguished above in respect of claims 12 and 25. Claim 26 depends from patentable claim 25 and allowance is therefore required. Withdrawal of the §103 rejection over Hari in view of Clemens and Ferber and further in view of Wienand is respectfully requested.

### **Conclusion**


The instant application is believed to be in condition for allowance. A Notice of Allowance of claims 12, 15, 18 and 24-26 is respectfully requested. The Examiner is invited to telephone the undersigned at (908) 722-0700 if it is believed that further discussions, and/or additional amendment would help advance the prosecution of the instant application.

Please charge any insufficiency of fees, or credit any excess, to Deposit Account

No. 14-1263.

Respectfully submitted,

NORRIS MCLAUGHLIN & MARCUS, P.A.

By 

William R. Robinson  
Attorney for Applicants  
Reg. No. 27,224  
721 Route 202-206  
P.O. Box 5933  
Bridgewater, NJ 08807-5933  
Phone: (908) 722-0700  
Fax: (908) 722-0755

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